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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/493,487 | 01/28/2000 | Andrew Sharp | 34648/00430USPX | 2310 |

7590 06/04/2004
Jenkins & Gilchrist
1445 Ross Avenue, Suite 3200
Dallas, TX 75202

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| EXAMINER |
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NGUYEN, TU X

| ART UNIT | PAPER NUMBER |
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2684

23

DATE MAILED: 06/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/493,487

Applicant(s)

SHARP ET AL.

Examiner

Tu X Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Examiner comments

On telephone conversation May 21, 2004, applicant's representative requested claim 41 should be included for examination.

Response to Amendment

1. Applicant's arguments with respect to claims 1-41, have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 41 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains "plurality of sessions" subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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5. Claims 1-28, 31-34, 38 and 40-41, are rejected under 35 U.S.C. 102(e) as being anticipated by Lintulampi (US Patent 6,377,804).

Regarding claim 1, Lintulampi discloses a communication system comprising:

a UMTS network is capable of handling a first number of communications between a mobile user equipment (see col.3 lines 15-35),

a GSM network is capable of handling a second number of communications between a mobile user equipment (see col.2 lines 32-35), and

wherein at least one of the mobile user equipment and the communication system contain at least one means for evaluating if a handover between the UMTS material and GSM material should be effectuated (see par.3 lines 62-64 and col.4 lines 47-50, see par.6 lines 4-7) and

at least one means (see col.4 lines 40-64. "the request quality of service" corresponding to "at least on means") for selecting (see col.3 lines 51-64), in the case that the handover is necessary, which communication or communications are handed over and

at least one means for executing the at least one decision (see col.6 lines 4-7, "the MS then automatically" (mobile device or network system inherently includes programmable software and/or Micro controller switching circuit reads on "one means").

Regarding claims 15 and 40, Lintulampi discloses method for managing a communication system, with at least two different access networks, wherein a first access network is capable of handling a first number of communications between a mobile user equipment and the first access network, and wherein a second access

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network is capable of handling a second number of communications between the mobile user equipment and the second access network (see col.3 lines 15-65), said method comprising the steps of:

Evaluating if a handover from the first access network to the second access network should be effected (see par.3 lines 62-64 and col.4 lines 47-50, see par.6 lines 4-7); and

Selecting, in the case of the handover is necessary, which communication for communications are handed over (see col.3 lines 51-64).

Regarding claim 41, Lintulampi discloses everything as claim 1 above. More specifically, Lintulampi disclose plurality of sessions (see col.5 lines 19-40).

Regarding claim 2, Lintulampi discloses at least one means for determining a capability of at least one of the UMTS and GSM networks (see col.6 lines 4-7).

Regarding claims 3, 5, Lintulampi discloses the means for determining the capability is located in a core network (see col.3 lines 44-50 and col.4 lines 47-49).

Regarding claim 4, 7-8, Lintulampi discloses at least on of the UMTS and GSM network contains the means for executing the at least one decision (see col.5 lines 64-66).

Regarding claim 6, 9-11, Lintulampi discloses the mobile user equipment contains the means for executing the at least one decision (see col.6 lines 4-6).

Regarding claim 12, 14, Lintulampi discloses the device is located in at least one of the UMTS and GSM network (see fig.1).

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Regarding claim 13, Lintulampi discloses the device is located in a radio network controller (see col.3 lines 44-50, "BSS" has BTS, and BSC which corresponds to RNC).

Regarding claims 16-17, Lintulampi discloses an access network sends a handover query to the mobile user equipment (see fig.4 a,b and col.3 line 44 through col.4 line 64).

Regarding claim 18, Lintulampi discloses the core network adds information about a communication or communications which can be supported (see col.3 lines 44 through col.4 line 64).

Regarding claim 19, Lintulampi discloses enabling a mobile user to decide whether the communication or the communications should be handed over to the second access network (see col.5 line 64 through col.6 line 14).

Regarding claim 20, Lintulampi discloses the mobile user equipment informs the access network about the communication or the communications which should be handed over to the second access network (see col.4 lines 44-64).

Regarding claims 21 and 23, Lintulampi discloses the mobile user equipment receives a handover query for handover toward the second access network, then the mobile user equipment disconnects all connections that cannot be kept in the second access network (see col.4 lines 55-59).

Regarding claim 22, Lintulampi discloses the core network decides which communication or communications should be handed over to the second access network (see col.3 lines 44-50 and col.4 lines 45-46).

Regarding claims 24-26, Lintulampi discloses the presettings are located within a mobile user equipment (see col.3 lines 15-50 and col.4 lines 40-46, "QoS parameters" corresponds to "presetting").

Regarding claim 27, Lintulampi discloses a message which depends on the presettings is sent to the core network after the core network has sent a request to the mobile user equipment (see col.4 lines 40-65).

Regarding claim 28, Lintulampi discloses the presettings are stored within at least one of an access network and a core network (see col.3 lines 44-64, and col.4 lines 44-46, QoS parameters corresponds to presettings with the broadest interpretation).

Regarding claim 31, Lintulampi discloses the presettings can be different for different categories of communications (see col.3-4, service parameters of each different network corresponds to different categories).

Regarding claim 32, Lintulampi discloses the presettings can be different priorities for different communications (see col.4 lines 44-45, QoS parameters reads on priorities).

Regarding claim 33, Lintulampi discloses the presettings are defined and modified by an operator (see col.3 lines 49-50).

Regarding claim 34, Lintulampi discloses the presettings are defined and modified by a mobile user (see col.4 lines 44-46).

Regarding claim 38, Lintulampi discloses the mobile user equipment contains an indicator that an intersystem handover is needed (see col.3 lines 40-45).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 29-30, are rejected under 35 U.S.C. 103(a) as being unpatentable over Lintulampi.

Regarding claims 29-30, Lintulampi fail to mention the presetting can be different/identical for each mobile user. The examiner takes an Official notice that It would have been obvious to one of ordinary skill in the art at the time the invention was made the concept million of mobile user some are different and some are identical and being categorized in a database are well know in the art in order to provide different purposes such as saving memory space, consumer categories, etc.

8. Claims 35-37 and 39, are rejected under 35 U.S.C. 103(a) as being unpatentable over Lintulampi in view of Byrne (US Patent 5,737,703).

Regarding claim 35-37 and 39, Lintulampi discloses everything as claim 1 above. However, Lintulampi fails to disclose "holding at least one of the communication before an intersystem handover; and maintaining said at least one of the communications on hold during and after the intersystem handover".

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Byrne disclose "holding at least one of the communication before an intersystem handover; and maintaining said at least one of the communications on hold during and after the intersystem handover" (see abstract, col.8 lines 15-45, "maintain both connection for a period of time" reads on "communications on hold"). Therefore, It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Lintulampi with the above teaching of Byrne in order to provide substantially simultaneously communicate with respective radio system during said handover from first to second radio system, thereby inhibiting any loss of call or communication.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tu Nguyen whose telephone number is (703) 305-3427. The examiner can normally be reached on Monday through Friday from 8:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MAUNG NAY A, can be reached at (703) 308-7749.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 2600 Customer Service Office at (703) 306-0377.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314 (Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal

Drive, Arlington. VA., Sixth Floor (Receptionist).

TN

May 24, 2004

Quochien B. Vuong 5/31/04

**QUOCHIE B. VUONG
PRIMARY EXAMINER**